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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,498	02/19/2002	Ernst-Walter Hillebrand	HILL 102	7649

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EXAMINER

OLTMANS, ANDREW L

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,498

Applicant(s)

HILLEBRAND, ERNST-WALTER

Examiner

Andrew L Oltmans

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claims 3-4, the claims recite a “conversion coat” applied to the zinc/nickel coating. It is unclear how the conversion coat is applied because the parent claim recites the passivating of the zinc/nickel surface. Therefore, it is unclear where in the process the “conversion coat” takes place. To obviate the rejection, the applicant could amend the claim to recite in line 2 of claim 3 that the conversion coat is applied “to the passivated zinc/nickel coat”.

- b. In claim 5, the claims recites the step “dry lubricant is applied”, however, there is no indication where in the process the dry lubricant is applied or where the dry lubricant is place. To obviate the rejection, the applicant could amend the claim to recite in line 2 of claim 5 that the dry lubricant is applied “to the passivated zinc/nickel coat”.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

NOTE: In the following rejections, the term “galvanic zinc/nickel coatings” (see e.g. claim 1, line 1) in the claims is interpreted as being a zinc and/or nickel containing coating, wherein the coating has galvanic properties.

EP 0 760 401 A1 Inoue et al.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 760 401 A1 Inoue et al. (EP ‘401; cited on IDS filed March 26, 2002).

EP ‘401 teaches method of passivating galvanic zinc/nickel coating wherein the coating is contacting with a composition that includes an oxidizing agent, wherein the oxidizing agent includes peroxide sulfate (i.e. ammonium persulfate) (page 2, lines 39-43 and page 3, lines 46-48). EP ‘401 further teaches that the passivated surface may be coated (i.e. with a conversion coat) with an organic or inorganic composition wherein the organic composition encompasses polymer wax (page 3, lines 51-55). The claims do not distinguish over the teachings of EP ‘401.

SU 1801987 A1 Nagirnyi et al., JP 01255675 A Nisshin Steel, JP 61238979 A Kobe Steel and JP 60121275 A Sumitomo Metal

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by each of SU 1801987 A1 Nagirnyi et al. (SU ‘987; cited on IDS filed March 26, 2002), JP 01255675 A Nisshin Steel (JP ‘675; cited on IDS filed March 26, 2002), JP 61238979 A Kobe Steel (JP ‘979; cited on IDS filed March 26, 2002) and JP 60121275 A Sumitomo Metal (JP ‘275; cited on IDS filed March 26, 2002).

SU '987, JP '675, JP '979 and JP '275 teach a method of passivating galvanic zinc/nickel coating wherein the coating is contacting with a composition that includes an oxidizing agent (see the English language abstracts of each of the references). The claims do not distinguish over the teachings of SU '987, JP '675, JP '979 and JP '275.

JP 60121275 A Sumitomo Metal

6. Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60121275 A Sumitomo Metal (JP '275; cited on IDS filed March 26, 2002).

JP '275 teaches and is applied as above in paragraph 5. JP '275 further teaches that the passivated Ni alloy is conversion coated with a conversion coated with a phosphate or chromate, wherein the film including an organic high polymer composition (i.e. polymer wax) (see English Language translation of abstract). The claims do not distinguish over the teachings of JP '275.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

JP 60121275 A Sumitomo Metal and EP 0 760 401 A1 Inoue et al.

NOTE: References to JP '449 are to the English language abstract or the English language translation provided by the examiner.

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8. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60121275 A Sumitomo Metal (JP '275; cited on IDS filed March 26, 2002) and EP 0 760 401 A1 Inoue et al. (EP '401; cited on IDS filed March 26, 2002) in view of JP 05237449 A Kawasaki Steel (JP '449).

JP '275 and EP '401 teach and are applied as set forth in paragraphs 4-6 above.

JP '275 and EP '401 fail to meet all the limitations of the instant claims in that Baldwin does not explicitly teach the application of a dry lubricant.

JP '449 teaches that galvanic coating that are passivated are conventionally coated with a dry lubricant coating containing a polyolefin wax (i.e. a wax such as that claimed in claim 4), wherein the lubricating resin improves, among other things, multistage moldability at high speed (abstract, paragraphs [0001] to [0005] and paragraph [0012]).

One of ordinary skill in the art at the time that the invention was made would have found the invention to be obvious because one of ordinary skill in the art would have been motivated to add the lubricant coating of JP '449 to the passivated galvanic coatings of JP '275 or EP '401 in order to provide the desirable properties of lubricity of multistage moldability at high speed, as taught in JP '449 (see abstract).


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached 7:00-3:30 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Andrew L. Oltmans
Examiner
Art Unit 1742

August 13, 2003